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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,354	02/26/2002	Brian Jacobsen	38627-170421	2756
26694	7590	02/06/2006	EXAMINER	
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20045-9998				ABEL JALIL, NEVEEN
		ART UNIT		PAPER NUMBER
		2165		

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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Venable, LLP
P.O. Box 34385
Washington, DC 20045-9998

In re Application of: Brian Jacobsen et al.)
Application No. 10/082,354)
Filed: February 26, 2002)
For: Subject Specific Search Engine)

**DECISION ON IMPROPER
PRIOR ART CITATION
UNDER 37 C.F.R. § 1.501**

Receipt of a citation of prior art filed under 37 C.F.R. § 1.501 by co-inventor Brian Jacobsen on January 27, 2006, in the above-identified application is hereby acknowledged. Because the prior art citation was filed before the date of the patent grant, it is not a proper submission under 37 C.F.R. § 1.501 and 35 U.S.C. § 301.

Accordingly, the citation will not be made of record in the file¹.

BASIS OF THE DECISION

35 U.S.C. § 301 Citation of prior art.

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular **patent**. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof **will become a part of the official file of the patent**. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

37 C.F.R. § 1.501 Citation of prior art in patent files.

(a) At any time during **the period of enforceability of a patent**, any person may cite, to the Office in writing, prior art consisting of patents or printed publications which that person states to be pertinent and applicable to the patent and believes to have a bearing on the patentability of any claim of the patent. If the citation is made by the patent owner, the explanation of pertinency and applicability may include an explanation of how the claims differ from the prior art. Such citations shall be entered in the patent file except as set forth in §§ 1.502 and 1.902.

¹ The Office no longer returns improper papers.

ANALYSIS

35 U.S.C. § 301 and 37 C.F.R. § 1.501(a) are reproduced above with emphasis added to highlight key phrases which inform this decision.

35 U.S.C. § 301 is a provision for citation of prior art which bears on “the patentability of any claim of a particular *patent*”. Such a citation “will become a part of the official file of the *patent*”. [Emphasis added].

The Office implemented this portion of the statute through 37 C.F.R. § 1.501 which is entitled “Citation of prior art in *patent* files” [Emphasis added]. Rule 501(a) sets the time during which a citation may be filed as “the period of enforceability of a patent”.

As of the date of this decision, the application under examination has not matured into a patent. Therefore, the submission of prior art under 37 C.F.R. 1.501 is not proper since it does not bear on a claim of a *patent* and there is no patent for which a period of enforceability applies.

DECISION

Accordingly, the submission is not being entered into the file. Applicant may resubmit the prior art citation under 501 after the patent issues or may consider submitting it, as an IDS which complies with rules 97 and 98, in the pending application.

Any inquiries with respect to this decision may be addressed to the undersigned.

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